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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,954	07/22/2002	Stephen Arkinstall	ARKINSTALL=1	4903
1444 7590 12/26/2007 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
COLEMAN, BRENDA LIBBY				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
12/26/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/070,954

Applicant(s)

ARKINSTALL ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12,20-22,27-31,35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12,20-22,27-31,35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-3, 5-12, 20-22, 27-31, 35 and 36 are pending in the application.

This action is in response to applicant's amendment filed November 8, 2007.

Claims 9, 11, 21 and 36 have been amended.

Response to Amendment

Applicant's amendments and arguments filed November 8, 2007 have been fully considered with the following effect:

1. With regards to the provisional obviousness-type double patenting rejection of claims 1-3 and 5-41 labeled paragraph 1 over copending Application No. 10/381,200 maintained in the last office action, the applicants requested that this rejection be held in abeyance at this time.

Claims 1-3, 5-12, 20-22, 27-31, 35 and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/381,200, for reasons of record and stated above.

2. With regards to the provisional obviousness-type double patenting rejection of claims 1-3 and 5-41 labeled paragraph 2 over copending Application No. 10/381,665 maintained in the last office action, the applicants requested that this rejection be held in abeyance at this time.

Claims 1-3, 5-12, 20-22, 27-31, 35 and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable

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over claims 1-16 of copending Application No, 10/381,665, for reasons of record and stated above.

3. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. 112, second paragraph rejection of claim 36 labeled paragraph 3, maintained in the last office action, which is herein **withdrawn**.
4. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. 112, first paragraph rejection of claim 9 labeled paragraph 4, of the last office action, which is herein **withdrawn**.
5. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. 112, second paragraph rejections of claims 10, 11, 21 and 22 labeled paragraph 5, of the last office action, which are herein **withdrawn**.

In view of the amendment dated November 8, 2007, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

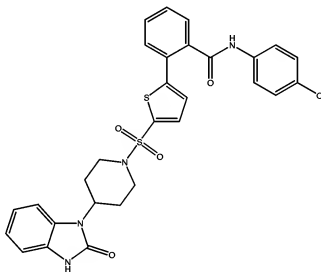
The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment to the 13th species (3rd species from the bottom of page 10 of the amendment filed November 8, 2007) and the 29th species (4th species on page 12 of the amendment) where "acetamide" was deleted and "benzamide" was inserted is not described in the specification with respect to the genus of formula I. The structure of the 13th species which is as follows:



N-(4-chlorophenyl)-2-(5-((4-(2-oxo-2,3-dihydro-1H-benzimidazol-1-yl) piperidin-1-yl)sulfonyl)thien-2-yl)benzamide

has the NR¹ attached to the 4-chlorophenyl (N-4-chlorophenyl) and thus does not fall within the genus of formula I where the C(=X) is attached to Ar¹.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 9, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

- a) Claim 9 is vague and indefinite in that it is not known what is meant by the definition of the substituents on the aryl and heteroaryl groups which is not stated in the form of a proper Markush grouping.
- b) Claim 21 is vague and indefinite in that it is not known what is meant by the definition of n which is an integer of from 0 to 5 and also n is defined as "selected from the group consisting of hydrogen, substituted or unsubstituted C₁-C₆ alkyl, substituted or C₁-C₆ alkoxy, OH, halogen, nitro, cyano, sulfonyl and oxo".
- c) Claim 21 is vague and indefinite in that it is not known what is meant by the variable (R⁶) which is not defined within the claim.
- d) Claim 21 is vague and indefinite in that it is not known what is meant by "consisting" in the definition of n.
- e) Claim 21 is vague and indefinite in that it is not known what is meant by a C₁ alkenyl in the definition of L¹ and L².
- f) Claim 21 is vague and indefinite in that it is not known what is meant by a C₁ alkynyl in the definition of L¹ and L².
- g) Claim 21 is vague and indefinite in that it is not known what is meant by a cyclic C₁ or C₂ alkyl in the definition of L¹ and L².

- h) Claim 21 is vague and indefinite in that it is not known what is meant by the period that appears at the end of the 15th line on page 38.
- i) Claim 21 is vague and indefinite in that it is not known what is meant by the capital letter in the moiety Heteroaryl-C₁-C₆ alkyl.
- j) Claim 21 is vague and indefinite in that it is not known what is meant by the moiety (SO₂)R³ where it is believed that the applicants' intended a subscript 2.
- k) Claim 21 is vague and indefinite in that it is not known what is meant by a C₁ alkenyl in the definition of R³ and R^{3'}.
- l) Claim 21 is vague and indefinite in that it is not known what is meant by a C₁ alkenyl in the definition of the substituents of the aryl or heteroaryl groups.
- m) Claim 21 is vague and indefinite in that it is not known what is meant by a C₁ alkynyl in the definition of the substituents of the aryl or heteroaryl groups.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brenda L. Coleman/
Primary Examiner, Art Unit 1624